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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,127	03/19/2004	Jeffrey W. Johnson	10346.70000US01	6397
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EXAMINER				
BETTT, JACOB F				
ART UNIT		PAPER NUMBER		
2169				
MAIL DATE		DELIVERY MODE		
09/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/804,127

**Applicant(s)**

JOHNSON, JEFFREY W.

**Examiner**

Jacob F. B  tit

**Art Unit**

2169

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 June 2008 has been entered.

***Remarks***

2. In response to communications filed on 26 June 2008, claims 1, 10, 19, and 21 have been amended per the applicant's request. Claims 1-21 are presently pending in the application.

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not describe what is meant by "computer readable medium". The applicant should supply a definition for "computer readable medium" in the specification that conforms to MPEP §2163.07 I.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 states “[a] system for managing digital records for an organization, the method comprising”. Since both the term “system” and the term “method” are used, it is unclear from this claim what statutory category of invention is being claimed. The applicant should clarify the claim in such a manner as to make the category of invention more evident.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In paragraph 0018 of the specification the applicant has provided evidence that the applicant intends the claimed “means” to be made up entirely of software in at least one embodiment. Software is not one of the four categories of invention and therefore this claim is not statutory. Software is not a series of steps or acts and thus is not a process. Software is not a physical article or object and as such is not a machine or manufacture. Software is not a combination of substances and therefor not a composition of matter.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 7, 8, 10, 16, 17, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams et al. (U.S. patent No. 5,815,657).

As to claim 1, Williams et al. teaches a method of managing digital records for an organization,  
the method comprising:

receiving a request for an action on a digital record, said digital record comprising critical elements (see column 20, lines 20-40);

presenting one or more profiles for at least one of the critical elements, the one or more profiles being predetermined so as to instantiate digital record management procedures of the organization by preventing a selection of an invalid profile (see column 19, lines 29-40);

receiving a selection of one of the one or more profiles (see figure 6, reference character 634); and

executing the action based on the selection (see figure 6, reference character 640).

As to claim 7, Williams et al. teaches wherein a selection of one of the critical elements for which the one or more profiles will be presented is based on the requested action (see column 19, lines 20-26).

As to claim 8, Williams et al. teaches further comprising: permitting modification of the profiles only by authorized users (see column 17, lines 41-47).

As to claim 10, Williams et al. teaches a digital record system for managing digital records of an organization, said digital records comprising critical elements, said system comprising:

a computer processor (see figure 1A, reference number 110); and

a memory device coupled to said processor (see figure 1A, reference numbers 114 and 116), said memory device having instructions stored thereon that, when executed by said processor, cause the system to:

based on a received request for an action on a digital record, display a menu of one or more profiles for at least one of the critical elements, the one or more profiles being predetermined so as to instantiate digital record management procedures of the organization by preventing a selection of an invalid profile (see column 19, lines 20-40); and

based on a received selection of one of the one or more profiles, execute the action (see figure 6, reference number 640).

As to claim 16, the applicant is directed to claim 7 above.

As to claim 17, the applicant is directed to claim 8 above.

As to claim 19, Williams et al. teaches a computer readable medium having instructions stored thereon that, when executed by a processor, cause the processor to:

in response to a received request for an action on a digital record of an organization, said digital record comprised of a plurality of critical elements, display a menu of one or more

profiles for at least one of the critical elements, the one or more profiles being predetermined so as to instantiate digital record management procedures of the organization by preventing a selection of an invalid profile (see column 19, lines 20-40); and

in response to a received selection of one of the one or more profiles, execute the action (see figure 6, reference number 640).

As to claim 21, Williams et al. teaches a system for managing digital records for an organization, the method comprising:

means for receiving a request for an action on a digital record, said digital record comprising critical elements (see column 19, lines 20-40);

means for presenting one or more profiles for at least one of the critical elements, the one or more profiles being predetermined so as to instantiate digital record management procedures of the organization by preventing a selection of an invalid profile (see column 19, lines 29-40);

means for receiving a selection of one of the one or more profiles (see figure 6, reference number 634); and

means for executing the action based on the selection (see figure 6, reference number 640).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-6, 9, 11-15, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. in view of Gardos et al. (U.S. patent No. 6,880,007 B1).

As to claim 2, Williams et al. does not distinctly disclose wherein the digital record is a domain name record.

However, Gardos et al. teaches wherein the digital record is a domain name record (see column 8, line 66 through column 9, line 29, where a new domain name is being registered and could be paid for using the method of Williams et al. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Williams et al. to include the teachings of Gardos et al. because these teachings would make it easier to purchase new domain names without separately entering credit card information into the system.

As to claim 3, Williams et al. as modified, teaches wherein the action comprises registering the domain name record (see Gardos et al., column 8, line 66 through column 9, line 29).



As to claim 4 Williams et al., as modified, wherein the action comprises modifying the domain name record (see Gardos et al., column 8, line 66 through column 9, line 29).

As to claim 5, Williams et al., as modified, teaches wherein the critical elements comprise contact information (see Williams et al., column 11, lines 17-30 and see Gardos et al., column 7, lines 1-25).

As to claim 6, Williams et al., as modified, teaches wherein the critical elements comprise domain name server information (see Gardos et al., column 10, lines 38-51).

As to claim 9, Williams et al., does not distinctly disclose further comprising: interfacing with a domain name registrar to execute the action.

However, Gardos et al. teaches registering a domain name record with billing information (see column 8, line 66 through column 9, line 29, where a new domain name is being registered and could be paid for using the method of Williams et al.). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Williams et al. to include the teachings of Gardos et al., because these teachings would make it easier to purchase new domain names without separately entering credit card information into the system.

As to claim 11, the applicant is directed to claim 2 above.

As to claim 12, the applicant is directed to claim 3 above.

As to claim 13, the applicant is directed to claim 4 above.

As to claim 14, the applicant is directed to claim 5 above.

As to claim 15, the applicant is directed to claim 6 above.

As to claim 18, the applicant is directed to claim 9 above.

As to claim 20, the applicant is directed to claim 2 above.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob F. Bétit whose telephone number is (571)272-4075. The examiner can normally be reached on Monday through Friday 10:30 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571) 272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

jfb  
12 Sep 2008

/Tony Mahmoudi/  
Supervisory Patent Examiner, Art Unit 2169